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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/629,210 | 07/28/2003 | Daniel G. Brady | 27556 | 5311 |

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EXAMINER

PREBILIC, PAUL B

ART UNIT PAPER NUMBER

3738

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,210

Applicant(s)

BRADY ET AL.

Examiner

Paul B. Prebille

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Specification

The disclosure is objected to because of the following informalities:

On page 4, line 20, the term "Aultrathin" is misspelled.

On page 9, line 28, the term "material=s" contains a typographical error.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-10, 15-17, 21-25, and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Peyman et al (US 6,197,057). Peyman anticipates the claim language where the primary lens as claimed is met by the intraocular lens already implanted of Peyman, and the supplemental lens as claimed is the supplemental lens of Peyman et al; see the abstract, column 9, lines 7-42, and column 5, line 64 to column 6, line 4.

Regarding claims 7, 21, and 29, Applicants are directed to Figure 21 and column 8, lines 42-59 where Peyman discloses an embodiment where the supplemental lens is anteriorly vaulted.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman (US 6,197,057) in view of Patel (US 5,366,502). Peyman meets the claim language as explained supra but fails to use of a multifocal or toric diffractive lens as claimed. However, Patel teaches that such lenses were known; see column 8, lines 1-10. Therefore, it is the Examiner's position that it would have been obvious to use an multifocal or toric lens in the Peyman invention for the same reasons that Patel uses the same and in order to enable near and far vision (via a multifocal lens) and to aid a patient with an astigmatism (via a toric lens).

Claims 4-6, 18-20, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman et al (US 6,197,057) in view of Portney (US 6,197,058) or Nordan et al (US 2003/0097176). Peyman meets the claim language as explained in the Section 102 rejection above, but fails to teach the thickness of the diffractive supplemental lens as claimed. However, Portney (see column 7, lines 59-62) and Nordan (see abstract) both teach that lens thicknesses of less than 250 microns were known. Therefore, it is the Examiner's position that it would have been prima facie obvious to make the Peyman supplemental lens less than 250 microns thick for the same reasons as the secondary references, and in order to make the lens insertable through a small incision.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman et al (US 6,197,057) in view of Copeland et al (US 2002/0042653). Peyman meets the claim language as explained in the Section 102 rejection above but fails to teach a blue blocker or tint feature as claimed. However, Copeland teaches that

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it was known to incorporate blue blocking or tint into intraocular lenses prior to the invention of the Applicants' invention; see the abstract. Therefore, it is the Examiner's position that it would have been prima facie obvious to incorporate blue blocker or tint into the lens of Peyman for the same reasons that Copeland does the same, that is, to achieve maximum visual acuity.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul B. Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
Art Unit 3738